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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,206	12/13/2001	Herbert Wolter	060953-0129	2412

7590 11/19/2003

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 11/19/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,206

Applicant(s)

WOLTER ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election (Paper No. 8), without traverse, of the compound which appears of page 9 of the election (and in new claim 21) is acknowledged. The election/restriction is hereby made FINAL.

Specification

The abstract of the disclosure is objected to because it is merely a copy of the first page of the corresponding PCT application. An acceptable abstract must appear as clean text on a separate sheet. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: many of the subscripted and superscripted letters/numerals which appear in the formulas in the text are illegible, for instance, in general formula (I) on page 4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The parentheses, brackets, etc. in general formula (I) are

ambiguous. That is, their instant arrangement does not define coordinatively possible arrangements of atoms. The examiner respectfully suggests that this is a typographical error brought about by an inadvertent transposition of one or more parentheses or brackets such that they no longer 'nest.'

Claims 1-8, 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Many of the subscripted and superscripted letters/numerals which appear in the formulas in the text are illegible, for instance, in general formula (I) in claim 1.

The remaining claims are also rejected under 35 USC 112, second paragraph, as claims which depend from indefinite claims are also indefinite. *Ex parte Cordova*, 10 USPQ 2d 1949, 1952 (PTO Bd. App. 1989).

Allowable Subject Matter

The elected species has been searched and is deemed free of the prior art. The search was therefore expanded as called for under current Office Markush practice. This resulted in all remaining species being searched and also deemed free of the prior art.

Claims 1-9 and 11-22 would be allowable once the objections and 112 rejections outlined in this Office Action have been overcome. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be DE 40 11 044 A1, cited by the applicant in the IDS and the specification, which teaches compounds structurally related to those of the instant invention, for instance the compound on page 9 line 25. This perhaps may be most easily seen by focusing on applicant's narrow definition of instant variable B of general formula (I), i.e. that the organic radical must have, inter alia, one or more acrylate or methacrylate moieties and the C of the C(O)N moiety in general formula (I) must be bonded to another C atom while the N must be bonded to a moiety ultimately bonded to the Si atom. The cited prior art neither teaches nor suggest the instant compounds. Nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the compounds of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 5,717,125 and US 6,124,491 are cited to show related compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 703-305-7129. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
November 12, 2003